

09/538,466
Art Unit 3625
8755.00

Response to Claim Objection

The term "duplicate" of claim 1(c) refers to the term "duplicate" in claim 1(b), which is contained in the phrase "duplicate of each code."

Numerous different ways exist to express a given concept in written form. Applicant chose that of claim 1.

In this connection, Applicant points to the following MPEP sections:

§ 2173.02 CLARITY AND PRECISION

Examiners . . . should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

Definiteness of claims language must be analyzed, **not in a vacuum**, but in light of (1) the content of the particular application disclosure . . .

§ 2173.01 CLAIM TERMINOLOGY

. . . a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

Applicant respectfully submits that

- 1) the grammatical structure of claim 1 and

09/538,466
Art Unit 3625
8755.00

2) the Specification itself

make clear what "duplicate" in claim 1(c) means. It is a "duplicate" of a "code."

Response to 112 - Rejections

"Codes" in Claims 1 - 3

The term "the codes" in claim 1(b) refers to the codes in claim 1(a). While it is correct that claim 1(a) contains the term "code," which is singular in number, nevertheless, under the rules of English grammar, a plural number of codes is recited.

The reason is that the word "code" is contained in the phrase "items of merchandise in a rack, each bearing a unique code." Since "items" is plural, and each item bears a "code," a plural number of codes is recited.

Thus, "the codes" in claim 1(b) is supported by the plural number of codes recited in claim 1(a). This applies to dependant claim 2 and claim 3.

Functionality of Items in Rack

Claims 1 and 2 were rejected, on the grounds that "it is unclear . . . how the items in a rack can impart functionality in a system."

In response, Applicant points out that the objection is asserting that every element in a claim must "impart

09/538,466
Art Unit 3625
8755.00

functionality." The undersigned attorney is unaware of such a requirement in the law of patents, and requests that a statute, regulation, court decision, or other source of authority be cited in support of the rejection.

Further, the claims in question can be viewed as reciting a type of delivery system. The items which are delivered are the "items of merchandise in a rack" of claim 1(a). As such, they are not required to possess "functionality." They are objects which are processed by the system.

Further still, and from another point of view, Applicant respectfully submits that the rejection overlooks an important fact. While it may be difficult to precisely identify a machine-type "function" which the "items of merchandise in a rack" perform, nevertheless, the following fact seems self-evident.

FACT

If the "items of merchandise" were absent, then the system would have nothing to deliver, and thus any need for the invention would vanish.

Therefore, the "items of merchandise," even if assumed to be utterly passive and completely lacking in "function," nevertheless are clearly a necessary part of the claimed system. Without them, the system has no purpose.

Consequently, supplying purpose to the system can be viewed

09/538,466
Art Unit 3625
8755.00

as the "function" of the "items."

Still further, the "function" of the items can be viewed as implicit. The items are plainly desired by the customers, who ordered them, and who will pay for them. The function of the items is to satisfy desires of customers.

"Different Remote Location"

The phrase "different remote location" in claims 1 and 3 was rejected. In response, Applicant points out that the phrase cannot be removed from its context. The entire phrase is this:

. . . delivering a duplicate of each code to
a **different remote location** . . .

Under the rules of English grammar, this phrase refers to more than one location. This phrase states that "each code" goes to a location, and that those locations are different.

As to prior mention of a location for comparison, none is required. The phrase states that all remote locations are different. Thus, they are compared with each other. **No prior mention is required.**

What Other Indicia the Codes are Being Matched

Rejection was made to claims 1 - 4 on the grounds that "it is . . . unclear as with what other indicia the codes are being

09/538,466
Art Unit 3625
8755.00

matched."

Applicant points out that claim 1 does not recite matching. Therefore, the objection seems inapplicable to that claim.

Claim 2 states that the "means" of claim 1(c) determines matching. Claim 1(c) refers to two specific codes:

- 1) the duplicate (which the person brought)
and
- 2) the code on an "item."

Plainly, those two codes are compared for a match.

Further, Applicant points out that it is axiomatic that the claims are read in light of the Specification. The Specification states that the matching is done in order to make sure that a person carries away the correct package. Plainly, the matching is done between (1) the code brought by a person and (2) the code on a package which the person attempts to remove.

Section 112 explicitly states that "means-plus-function" language (such as claim 1(c)) is interpreted by reference to the Specification.

The preceding applies to claims 3 and 4. Specifically, Applicant points to claim 4(e):

- e) without human intervention at a check out station,
 - i) reading an identifying code from an order;

09/538,466
Art Unit 3625
8755.00

- ii) accepting an identifying code from a person;
- iii) comparing the codes and,
 - A) if they do not match, causing an alarm; and
 - B) if they do match, accepting payment without causing an alarm.

Plainly, the "match" of claim 4(e)(iii)(A) and (B) refers to matching between "the codes" of claim 4(e)(iii).

Plainly, "the codes" of claim 4(e)(iii) refers to the two codes of claim 4(e)(i) and 4(e)(ii).

Applicant fails to see any lack of clarity.

Response to 103 - Rejections

All claims were rejected as obvious, based on Cupps. Applicant interprets Cupps as follows.

Applicant's Characterization of Cupps

A person logs into the Internet, and finds a web page of a carry-out restaurant. The web page contains a menu. (Column 9, lines 37 - 42; column 10, lines 7 - 16.)

The customer places an order. (Column 10, lines 17 - 21.) The order is relayed to the restaurant. (Column 10, lines 20 - 42.) The order is identified by the customer's name. (Column 10,

09/538,466
Art Unit 3625
8755.00

bottom - column 11, top.)

A message may be sent to the customer, telling the customer when the order will be ready. (Column 11, lines 22 - 27.)

The restaurant then delivers the order to the customer's home. (Column 9, lines 16 - 33.)

Significant Features of Cupps

Applicant points out the following significant features of Cupps:

- 1) The customer's name (and possibly telephone number) are used to identify the order.
- 2) The order is delivered to the customer's home.

Analysis of Claims

Applicant's claim 1 recites:

1. A system, comprising:
 - a) items of merchandise in a rack, each bearing a unique code;
 - b) means for generating the codes, and delivering a duplicate of each code to a different remote location; and
 - c) means for
 - i) receiving a duplicate from a

09/538,466
Art Unit 3625
8755.00

person who transported the duplicate
from a remote location, and

ii) reading the code from an item
of merchandise.

An example may illustrate the usefulness of such a system.

A person may place an order with a cafeteria over the Internet. The cafeteria would transmit the "code" of claim 1(b) to the person, which identifies the order. The cafeteria would also "generate" a label, which is applied to the order when completed.

Thus, in terms of claim 1, an "item of merchandise" (the order) bears a unique code, as in claim 1(a). And different codes would be transmitted to different locations, for different customers, as in claim 1(b).

After receiving the unique code, the person travels to the cafeteria, taking the code along. The person finds the package bearing the matching code, and submits the package to the "means" of claim 1(c). The person also submits the code previously received to that "means."

That "means" determines whether the person selected the correct package, as in claim 2. That is, if the codes do not match, the person selected the wrong package.

09/538,466
Art Unit 3625
8755.00

Comparison with Cupps

Claim 1(b) recites "delivering a duplicate of each code to a different remote location." Applicant is unable to locate this element in Cupps, and requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify this element.

Applicant also requests that the "means" of claim 1(c) be identified in Cupps. That means (1) reads the code from an item of merchandise and (2) reads the "duplicate" which the person brought to the cafeteria.

In this connection, Applicant points out that it appears that Cupps has no use for such a "means." He delivers food to the homes of customers. Why would the customer deliver a code to a "means," and where is a teaching in Cupps to that effect?

Requests for Support

REQUEST 1

The Office Action asserts that Cupps' Figure 12A shows

issuing . . . unique identifying codes to persons placing the orders . . .

placing prepared orders in a bay/rack, each labeled with a respective identifying code and price in human readable format,

reading an identifying code from an order,

accepting the identifying code from a person,

. . .

09/538,466
Art Unit 3625
8755.00

comparing the code brought by the person to the code on the prepared order,

and

obtaining payment at the checkout station.

Applicant cannot confirm that Cupps' Figure 12A shows these elements, and requests that they be identified.

REQUEST 2

The Office Action asserts that it is "inherent" to issue an order number to the customer. MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Applicant requests that the "basis in fact and/or technical reasoning" be provided as required by this MPEP section.

One reason for this request is that the undersigned attorney has ordered both pizzas and Chinese food by telephone, and no order number was given to him. When he visited the restaurant, to pick up the order, the order was identified by his name.

09/538,466
Art Unit 3625
8755.00

REQUEST 3

The Office Action also asserts that it is "inherent" that "a user will carry with him the identification mark like order number or user's name to the Take-Out service." Applicant requests that the required "basis in fact" et al. be given for this inherency.

One reason is that, if the customer's name is used as the order number, that is, as the "unique code" of claim 1, then claim 1 is not actually shown in Cupps. Three reasons support this conclusion.

-- The customer's name is not "generated" as in claim 1(b).

-- A "duplicate" of the customer's name is not delivered to the customer as in claim 1(b).

-- The customer's name is not "unique" as in claim 1(a). (Suppose two customers named "Smith" place orders.)

Therefore, if the customer's name is treated as the "code" of claim 1, Cupps does not show claim 1.

REQUEST 4

The Office Action also asserts that it is "inherent" that a check out station identifies ordered food. Applicant requests that the required "basis in fact" et al. be given for this inherency.

09/538,466
Art Unit 3625
8755.00

One reason is that the Office Action clearly refers to a situation where a human clerk fetches an order, when a customer enters the restaurant and states his name. Claim 1(c) does not recite that, but recites a "means."

REQUEST 5

Applicant also requests that the required "basis in fact" et al. be given for the asserted inherency that a unique code number, contained on an invoice, is attached to an order. The undersigned attorney has purchased numerous items of take-out food, having no numbered invoice.

Further, claim 1 recites "generating" a code number. Invoices generally are pre-printed, and any serial number would have been printed by the invoice-printing-company.

re: Logic of Office Action

Applicant respectfully submits that the Office Action contains faulty logic. The Office Action asserts that

- 1) a person's name can qualify as a code,
- 2) in take-out restaurants, the person's name is sometimes attached to food orders, and
- 3) sometimes an invoice bearing a code is attached to the order.

Thus, the Office Action makes statements such as "Food orders

09/538,466
Art Unit 3625
8755.00

bearing names or codes are well known." That would be a true statement. However, it does not show claim 1.

That is, the statement can be true if the food order contains a name, but no code. In that case, claim 1 would not be shown, for the reasons given above. (Name is not "generated," not transmitted to customer, etc.)

Therefore, faulty logic is being used. True statements are invoked (which are true because of an "or" statement). But the true statements do not show claim 1 (because the truth is achieved through an element unrelated to claim 1).

re: Unmanned Station

The PTO relies on Official Notice that unmanned stations can (1) read codes and (2) sound alarms. The undersigned attorney respectfully traverses the Official Notice, and requests a citation of evidence showing the existence of such stations. (See MPEP § 2144.03.)

One reason is that the PTO relies on ATMs as sounding alarms. The undersigned attorney has written numerous patent applications on ATMs, and is unfamiliar with such alarms sounded by ATMs, in response to codes read from items.

A second reason is that, even if such stations exist, that does not show claim 2. Claim 2 recites (1) reading a code from an item, (2) accepting a code from a person, and (3) sounding an alarm

09/538,466
Art Unit 3625
8755.00

if the codes do not match.

re: Admitted Prior Art

In the Specification, page 9, Applicant stated:

Identity-proving to a robotic station is known in the art. Identification processes at Automated Teller Machines provide examples.

However, that does not admit that "check identity, read machine readable format and sound alarms if the codes do not match" is admitted to be found in the apparatus identified in the passage taken from the Specification, and quoted immediately above.

Teaching I

No valid teaching has been given for combining the Officially Noticed subject matter with Cupps. The rationale given is that, in the combination, the number of employees is reduced, thereby reducing costs and increasing profits. However, several problems exist in this rationale.

One is that the rationale is an unsupported conclusion. No evidence has been given, and evidence is required.

A second problem is that the rationale is probably false, or cannot be taken seriously. The rationale, in effect, states that robots can replace cashiers at McDonald's, and will save McDonald's money. Anybody who can design such a robot will instantly become

09/538,466
Art Unit 3625
8755.00

The World's Richest Man. The rationale cannot be taken seriously.

A third problem is that the rationale does not comply with the CAFC's decision of In re Dembiczak, 175 F. 3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In brief, Dembicza states that

- **objective evidence** of a teaching for combining references must be provided;
- the Examiner's speculation does not qualify as objective evidence;
- numerous sources can provide a teaching to combine references;
- knowledge of one skilled in the art can act as a source;
- however, THE RANGE OF SOURCES AVAILABLE DOES NOT DIMINISH THE REQUIREMENT FOR ACTUAL EVIDENCE;
- broad conclusory statements by the Examiner do not qualify as evidence; and
- "particular factual findings" as to the teaching are required, and gives reasons why **facts** are necessary.

No evidence, nor "particular factual findings," have been given.

A fourth problem is that the rationale, as a matter of logic,

09/538,466
Art Unit 3625
8755.00

does not lead to the claimed invention. The goal of the rationale is to increase profits. However, many elements cooperate to produce profit. Profit can be increased by (1) increasing price, (2) reducing costs of goods purchased, which are then sold, (3) reducing processing costs, (4) paying workers less, and so on.

The PTO has provided no teaching as to why **its particular mode of increasing profits** (installing special robots) should be taken. A teaching is required.

Teaching II

If the Office Action asserts that ATMs issue burglar alarms when tampering occurs, Applicant requests an explanation of how that leads to claim 1.

Specifically, where is the reading of codes, and comparison, etc. ?

Remaining Claims

The preceding applies to the remaining claims.

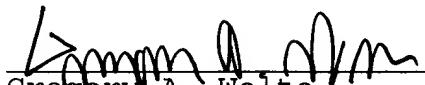
09/538,466
Art Unit 3625
8755.00

Conclusion

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,



Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 5
Dayton, OH 45479
November 8, 2002
(937) 445 - 2990

WELTE DIRECT: (765) 296 - 4699

ATTACHMENT: Four sheets of replacement Figures, labeled Figures 1 - 5, and bearing the legend "11/08/02 FRI 14:15 FAX 937 445 8394 NCR LAW DEPT." at right margin.